



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,595	11/26/2003	Masatomo Matsubara	325772033300	5975

7590 09/20/2010  
Barry E. Bretschneider  
Morrison & Foerster LLP  
Suite 300  
1650 Tysons Boulevard  
McLean, VA 22102

EXAMINER
----------

RUDOLPH, VINCENT M

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

09/20/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/721,595	<b>Applicant(s)</b> MATSUBARA ET AL.	
	<b>Examiner</b> Vincent Rudolph	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-24 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

Claim 16 is objected to because of the following informalities:

Regarding dependent claim 16, an "abbreviated image" is disclosed, but was not in independent claim 15. Rather a "thumbnail image" is disclosed, which is how the examiner will interpret the claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 11-14 and 18, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umebayashi ('765) in view of Berkema (Pub. # 20030002072).

Regarding claim 1, Umebayashi ('765) discloses an image forming apparatus (input device, **See Figure 1 and 19, Element 10**) that includes a holding portion (buffer, **See Figure 1, Element 7**) holding obtained image data (stores the digitized image data, **See Col. 4, Line 21-23**), an image-related information producing portion (attribute information generating means, **See Figure 1, Element 3**) producing image-related information related to the image data, which includes a thumbnail image corresponding to the image data (a thumbnail image of the image data is generated within the input device, **See Col. 7, Line 21-26**), a receiving portion (through the communication processing means, **See Figure 1, Element 5**) receiving output form instruction

information from an external device (receives the instruction to print the selected image data, **See Col. 5, Line 27-38**), and an image forming portion (image data output means, **See Figure 1, Element 1a**) forming image data for outputting from the image data held by the holding portion (once the image data is fetched, the image data is printed, **See Col. 5, Line 42-46**).

Umebayashi ('765) does not fully disclose that the image forming apparatus includes an operating portion accepting a user input designating an external device as a sending destination of image-related information, a sending portion that automatically sends the image-related information to an external device at the designated destination in response to the user input, such that the output for instruction information received includes an instruction relating to an output form of the image data and is determined based on the image-related information, and forming an image based on the received instruction information.

Berkema (Pub. # 20030002072) discloses that the image forming apparatus (print device, **See Figure 1, Element 106**) includes an operating portion (embodied within the print device) accepting a user input designating an external device as a sending destination of image-related information (the print device indirectly accepts user input for selecting a sending destination where the print content is available, **See Page 2-3, Paragraph 0022**, such that the image related information is included within the data set, **See Page 3, Paragraph 0025**), a sending portion (embodied within the print device) that automatically sends the image-related information to an external device at the designated destination in response to the user input (in response to receiving the

data set, the print device automatically establishes a communication with the designated location, **See Page 3, Paragraph 0027**), such that the output for instruction information received includes an instruction relating to an output form of the image data and is determined based on the image-related information (the print device pulls the content from the designated location, **See Page 4, Paragraph 0031**, which includes formatting the print content according to the settings on the print device, **See Page 4, Paragraph 0033**), and forming an image based on the received instruction information (print the print content by the print device, **See Page 4, Paragraph 0033**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include accepting user input for an external destination for sending image related information and receiving instructions for outputting it, such as the one disclosed within Berkema (Pub. # 20030002072), and incorporate it into the apparatus of Umebayashi ('765) because it allows the image data to be correctly outputted according to the printer's capabilities rather than being unable to have the image data outputted at the designated printer.

Regarding claim 3, Umebayashi ('765) discloses the receiving portion receives, as an output form, the output form instruction information instructing the print output of the image data (receives an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 4, Umebayashi ('765) discloses the image data is obtained by scanning each document forming a document group (places the manuscripts to be inputted as image data by a scanner, **See Col. 4, Line 8-10**), the image-related

information producing portion produces the image-related information for each document (generates the attribute information of the image data, **See Col. 4, Line 23-30**), and the receiving portion receives the output form instruction information instructing an output form for each of the documents (receives an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 11, Umebayashi ('765) discloses an image managing apparatus (browser unit, **See Figure 1, Element 30**) that includes a receiving portion (communication processing means, **See Figure 1, Element 34**) for receiving image-related information related to image data from the image forming apparatus (connects to receive the image attribute information, **See Col. 5, Line 6-11**), such that the image-related information includes a thumbnail image corresponding to the image data (a thumbnail image of the image data is generated, **See Col. 7, Line 21-26**), a display portion (display means, **See Figure 1, Element 31**) displaying the image-related information (displays the image information on the browser unit, such as the thumbnail image of the image data, **See Figure 18(d); Col. 7, Line 38-39**), an output form instruction information producing portion (embodied within the browser unit) producing output form instruction information of the image data held in the image forming apparatus (produce the instruction to print the selected image data, **See Col. 5, Line 22-35**), and a sending portion (through the communication processing means, **See Figure 1, Element 34**) sending the output form instruction information to the image forming apparatus (transmits a printing request for the selected image data, **See Col. 5, Line 33-38**).

Umebayashi ('765) does not disclose that the output instruction information includes an instruction relating to an output form of the image data, such that the output form determined is based on the received image-related information.

Berkema (Pub. # 20030002072) discloses an output instruction information includes an instruction relating to an output form of the image data, such that the output form determined is based on the received image-related information (the print device pulls the content from the designated location, **See Page 4, Paragraph 0031**, which includes formatting the print content according to the settings on the print device, **See Page 4, Paragraph 0033**, based on the data set within the reference initially received, **See Page 3, Paragraph 0025**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include an output form within the output instruction information, such as the one disclosed within Berkema (Pub. # 20030002072), and incorporate it into the apparatus of Umebayashi ('765) because it allows the image data to be correctly outputted according to the printer's capabilities rather than being unable to have the image data outputted at the designated printer.

Regarding claim 12, Umebayashi ('765) discloses the image managing apparatus further includes an accepting portion accepting the instruction operation using the thumbnail image and performed by a user for an output form (user selects the image data to be printed, **See Col. 5, Line 27-32**, using the thumbnail image, **See Col. 7, Line 38-40**).

Regarding claim 13, Umebayashi ('765) discloses that the output form instruction information producing portion produces as an output form, the output form instruction information instructing the print output of the image data (transmits an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 14, Umebayashi ('765) discloses the image data is obtained by scanning each document forming a document group (places the manuscripts to be inputted as image data by a scanner, **See Col. 4, Line 8-10**), the image-related information received from the image forming apparatus includes the image-related information for each document (generates the attribute information of the image data, **See Col. 4, Line 23-30**), and the output form instruction information producing portion produces an output form for each of the documents (transmits an instruction for the selected image data to output, **See Col. 7, Line 30-38**).

Regarding claim 18, the combination of Umebayashi ('765) and Berkema (Pub. # 20030002072) together discloses that the image-related information includes color information of the image data (the colors of the image data, **See Berkema (Pub. # 20030002072), Page 3, Paragraph 0025**).

Regarding claim 20, Umebayashi ('765) discloses that the image data is obtained by scanning (use an image scanner to scan data, **See Col. 4, Line 8-10**).

Regarding claims 8 and 22, the rationale provided in the rejection of claims 1, 11 and 20 is incorporated herein. In addition, the apparatus of claims 1, 11 and 20 corresponds to the method of claims 8 and 22 and performs the steps disclosed herein.



Claims 5-7, 9-10, 15-17, 19, 21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umebayashi ('765) in view of Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504).

Regarding claim 5, Umebayashi ('765) discloses an image forming apparatus (input device, **See Figure 1, Element 10**) that includes a holding portion (buffer, **See Figure 1, Element 7**) holding obtained image data (stores the digitized image data, **See Col. 4, Line 21-23**), and a thumbnail image producing portion (embodied within the input device) producing a image-related information, such as a first thumbnail image corresponding to the image data (a thumbnail of the image data is created, **See Col. 7, Line 8-9**).

Umebayashi ('765) does not fully disclose that the image forming apparatus includes an operating portion accepting a user input designating an external device as a sending destination of image-related information, a sending portion that automatically sends the image-related information to the designated external device in response to the user input, such that the output for instruction information received includes an instruction relating to an output form of the image data.

Berkema (Pub. # 20030002072) discloses that the image forming apparatus (print device, **See Figure 1, Element 106**) includes an operating portion (embodied within the print device) accepting a user input designating an external device as a sending destination of image-related information (the print device indirectly accepts user input for selecting a sending destination where the print content is available, **See Page 2-3, Paragraph 0022**, such that the image related information is included within the

data set, **See Page 3, Paragraph 0025**), a sending portion (embodied within the print device) that automatically sends the image-related information to an external device at the designated destination in response to the user input (in response to receiving the data set, the print device automatically establishes a communication with the designated location, **See Page 3, Paragraph 0027**), such that the output for instruction information received includes an instruction relating to an output form of the image data and is determined based on the image-related information (the print device pulls the content from the designated location, **See Page 4, Paragraph 0031**, which includes formatting the print content according to the settings on the print device, **See Page 4, Paragraph 0033**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include accepting user input for an external destination for sending image related information and receiving instructions for the image data, such as the one disclosed within Berkema (Pub. # 20030002072), and incorporate it into the apparatus of Umebayashi ('765) because it allows the user the ability to select a destination that is best suited to assist in outputting the image data accordingly.

Umebayashi ('765) further does not disclose when receiving the setting from the external device related to a thumbnail image, a second thumbnail image is produced that corresponds to the image data based on the received setting, and sending the second thumbnail image to the designated external device.

Phillips (Pub. # 20040205504) discloses receiving a setting from an external device, such that the setting relates to a thumbnail image (client receives a confirmation

on the user change from the server that was requested, such as a configuration changes related to thumbnail images, **See Page 2, Paragraph 0027**), and producing another thumbnail image based on the received setting and sending it to the designated external device (user is able to enter a different configuration for the related thumbnail image, **See Figure 6; Page 2, Paragraph 0030**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a setting for a thumbnail image and producing it, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Umebayashi ('765) because it allows the user to scroll and modify a selected thumbnail image in order to determine the best setting for outputting.

Regarding claim 6, the combination of Umebayashi ('765), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) discloses that the receiving portion receives the setting designating a resolution of the thumbnail image (resolution of the thumbnails, **See Phillips (Pub. # 20040205504), Page 3, Paragraph 0037**).

Regarding claim 7, the combination of Umebayashi ('765), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) discloses that the setting received by the receiving portion from the external device designates at least one of change of the thumbnail image and resending of the thumbnail image (client sends a change request and receives it in response in order for the client to process the received configurations change related to the thumbnail image, **See Phillips (Pub. # 20040205504), Page 2, Paragraph 0027**).

Regarding claim 15, Umebayashi ('765) discloses an image managing apparatus (browser unit, **See Figure 1, Element 30**) that includes a receiving portion (through the communication processing means, **See Figure 1, Element 34**) receiving a thumbnail image corresponding to the image data from an image forming apparatus, such that the image data is held in the image forming apparatus (connects to receive the image attribute information, **See Col. 5, Line 6-11**, which includes a thumbnail image of the image data, **See Col. 7, Line 21-26**), and a sending portion (embodied within the browser unit, **See Figure 1, Element 30**) for sending instruction providing an instruction related to reproducing a thumbnail image concerning the first thumbnail image to the image forming apparatus (sends an instruction for reproducing the image data, **See Col. 5, Line 27-38**, such that the thumbnail image is related to the image data, **See Col. 7, Line 42-50**).

Umebayashi ('765) does not disclose that the instruction information includes an instruction relating to an output from the image data held in the image forming apparatus.

Berkema (Pub. # 20030002072) discloses an output instruction information includes an instruction relating to an output from the image data held in the image forming apparatus (the print device pulls the content from the designated location, **See Page 4, Paragraph 0031**, which includes formatting the print content according to the settings on the print device, **See Page 4, Paragraph 0033**, based on the data set within the reference initially received, **See Page 3, Paragraph 0025**, based on the reference data held within the print device, **See Page 2-3, Paragraph 0022**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include an output form within the output instruction information, such as the one disclosed within Berkema (Pub. # 20030002072), and incorporate it into the apparatus of Umebayashi ('765) because it helps assisting the image data to be outputted accordingly.

Umebayashi ('765) further does not disclose a receiving portion receiving another thumbnail image reproduced at the image forming apparatus in compliance with the instruction information sent from the image managing apparatus to the image forming apparatus.

Phillips (Pub. # 20040205504) discloses a receiving portion (embodied within the server, **See Figure 1, Element 140**) receiving another thumbnail image reproduced at the image forming apparatus complying with the instruction information sent from the image managing apparatus to the image forming apparatus (receives a request for scrolling through different thumbnail images relating to configuration changes, **See Page 2, Paragraph 0030**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a receiving and sending an instruction for reproducing an abbreviated image, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Umebayashi ('765) because it provides assistance to the user in scrolling and modifying a selected thumbnail image in order to determine the best setting for outputting it.

Regarding claim 16, the combination of Umebayashi ('765), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) discloses that the instruction related to the thumbnail image instructs at least one of change of the thumbnail image and resending the abbreviated image (client sends a change request and receives it in response in order for the client to process the received configurations change, **See Phillips (Pub. # 20040205504), Page 2, Paragraph 0027**).

Regarding claim 17, the combination of Umebayashi ('765), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) discloses that the instruction related to the thumbnail image instructs the resolution of the thumbnail image (resolution of the thumbnails, **See Phillips (Pub. # 20040205504), Page 3, Paragraph 0037**).

Regarding claim 19, the combination of Umebayashi ('765), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) together discloses that the operation portion includes a user interface provided on the image forming apparatus that accepts the user input (operation panel within the operation means, **See Umebayashi ('765), Figure 1, Element 4**) that accepts the user input designating the external device (the print device indirectly accepts user input for selecting a sending destination where the print content is available, **See Berkema (Pub. # 20030002072), Page 2-3, Paragraph 0022**).

Regarding claims 21, Umebayashi ('765) discloses that the image data is obtained by scanning (use an image scanner to scan data, **See Col. 4, Line 8-10**).

Regarding claims 9-10 and 23-24, the rationale provided in the rejection of claims 5, 15 and 21 is incorporated herein. In addition, the image forming apparatus of claims

5, 15 and 21 corresponds to the image forming method of claims 9-10 and 23-24 and performs the steps disclosed herein.

***Response to Arguments***

Applicant's arguments, see remarks, filed 6/14/2010, with respect to the rejection of claims 1-4, 8, 11-14 and 18 under Umebayashi in view of Kimura as well as claims 5-7, 9-10, 15-17 and 19 under Umebayashi in view of Kimura and Phillips have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground of rejection is made in view of Umebayashi in combination with Berkema as applied to claims 1-4, 8, 11-14, 18, 20 and 22 as well as Umebayashi in combination with Phillips and Berkema as applied to claims 5-7, 9-10, 15-17, 19, 21 and 23-24. Thus, the prior art of Berkema is used in combination with Umebayashi as well as in combination with Umebayashi and Phillips and together does meet each limitation of the amended claims as disclosed within the rejection above.

Applicant's amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



Application/Control Number:  
10/721,595  
Art Unit: 2625

Page 16

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.  
Should you have questions on access to the Private PAIR system, contact the  
Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like  
assistance from a USPTO Customer Service Representative or access to the  
automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-  
1000.

Vincent Rudolph  
Examiner  
Art Unit 2625

/Vincent Rudolph/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625